

THIS ORDER IS
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THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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July 28, 2020

Cancellation No. 92071482

Anand K. Chavakula

v.

Praise Broadcasting AKA Praise FM

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of Praise Broadcasting AKA Praise FM's ("Respondent") motion for discovery pursuant to Fed. R. Civ. P. 56(d).¹

Background

This proceeding involves Respondent's Registration No. 5530327 issued on July 31, 2018 for the mark PRAISELIVE and design for "broadcasting of radio programmes, broadcasting programs via a global computer network, audio broadcasting" in International Class 38. Respondent filed the underlying application on February 7, 2018.

¹ Fed. R. Civ. P. 56(d) is applicable to Board inter partes proceedings by Trademark Rule 2.116(a). TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.02 (2020).

Certain cited cases applied the earlier codification of the Rule, Fed. R. Civ. P. 56(f). See Committee Notes on Rules - 2010 Amendment ("Subdivision (d) carries forward without substantial change the provisions of former subdivision (f).").

Anand K. Chavakula (“Petitioner”) filed a petition to cancel on the ground of priority and likelihood of confusion pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d). Petitioner alleges ownership of application Serial No. 88439914, filed on May 21, 2019, to register the mark PRAISELIVE for “broadcasting programs via a global computer network, audio broadcasting, radio broadcasting, sharing digitized music resources like lyrics, audio and video files through a global computer network of websites and social media” in International Class 38, and prior use since 2009.²

In its answer, Respondent denied the salient allegations in the petition to cancel and asserted affirmative defenses.

The Board set discovery to close on February 17, 2020.³ On November 18, 2019, Respondent served on Petitioner its First Set of Interrogatories, Requests for Documents and Requests for Admission.⁴ On December 18, 2019, Petitioner’s counsel served responses to the requests for admission, with an email stating: “The response [sic] to Interrogatories and Documents will be sent in a different email.”⁵ On December 19, 2019 and December 31, 2019, Respondent’s counsel, having not received responses to its interrogatories and document requests, sent emails inquiring as to their status, stating in the latter email “If we do not receive discovery from your client soon, we may be forced to file a motion to compel.”⁶

² 1 TTABVUE 4.

³ 2 TTABVUE 3.

⁴ 12 TTABVUE 5, 15-16. Respondent submitted with its motion the interrogatories and document requests it served. 12 TTABVUE 30-50.

⁵ 12 TTABVUE 5, 15, 19.

⁶ 12 TTABVUE 5, 16, 21, 24.

On January 2, 2020, Petitioner's counsel sent an email stating: "My apologies. I've been away from the office. I will take a look and resend."⁷ Petitioner did not serve the discovery responses. Six days later, Petitioner filed a motion for summary judgment.

In lieu of filing a brief in opposition, Respondent moved for discovery pursuant to Fed. R. Civ. P. 56(d), which the Board now considers. The motion is fully briefed.

Standard for Discovery under Rule 56(d)

Pursuant to Fed. R. Civ. P. 56(d), if a party served with a motion for summary judgment shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may 1) defer considering the motion or deny it; 2) allow time to obtain affidavits or declarations or to take discovery; or 3) issue any other appropriate order. Fed. R. Civ. P. 56(d). *See also* Trademark Rule 2.127(e)(1), 37 C.F.R. § 2.127(e)(1); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992). TBMP § 528.06. It is not sufficient that the party simply state in an affidavit supporting its motion under Fed. R. Civ. P. 56(d) that it needs discovery in order to respond to the motion for summary judgment; rather, the party must state specific reasons why it is unable, without discovery, to present facts essential to oppose the motion for summary judgment. *See Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1930 (TTAB 2015); *Orion Grp. Inc. v. Orion Ins. Co.*, 12 USPQ2d 1923, 1924-25 (TTAB 1989).

⁷ 12 TTABVUE 5, 16, 27.

If a party demonstrates a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion for summary judgment, discovery will be permitted, especially if the information sought is largely within the control of the summary judgment movant. The request for discovery should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable the party to respond to the motion for summary judgment. *See Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987); *see also* TBMP § 528.06.

Respondent's Motion and Declaration

In its motion, Respondent maintains that, in order to respond to Petitioner's summary judgment motion, it requires discovery regarding Petitioner's priority as well as certain likelihood of confusion factors.⁸ Respondent sets forth statements that Petitioner advances in its motion as "undisputed facts," and Respondent explains that it requires discovery regarding:

- 1) Petitioner's claim of priority, including whether its use has been interrupted, limited in territory, and qualifies as trademark use.

Respondent states that Petitioner's summary judgment motion includes "several Godaddy.com domain name receipts" not provided in discovery. Respondent states that it sought use-related matters in Interrogatory Nos. 4-5, 11-15, 17, 22-23 and 26-35, and Document Request Nos. 4-15, 18-27, 34, 37-39 and 44-45.⁹

⁸ Although Respondent does not cite a case, its arguments clearly refer to the various factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) ("*du Pont* factors").

⁹ 12 TTABVUE 8.

- 2) Petitioner's claim that the marks are similar, including how Petitioner's mark is displayed to the public and in advertising and promotional materials.

Respondent states that it sought these matters in Interrogatory Nos. 24-25 and 39, and Document Request No. 16.¹⁰

- 3) The strength of Petitioner's mark, including Petitioner's argument that its mark is prominently featured on its website and YouTube, and is advertised through various social media outlets.

Respondent states that it sought these matters in Interrogatory Nos. 4-5, 9, 11-16 and 26-38, and Document Request Nos. 4-6, 9-15, 18-31, 33-34, 40-41 and 45.¹¹

- 4) Petitioner's services and channels of trade, including whether its use is trademark use and in connection with its claimed services; each good or service it has offered or sold under its mark; and information on certain documents filed with the summary judgment motion but not produced in discovery, including communications with the FCC, the location of Petitioner's broadcast towers and the media through which Petitioner offers and sells its services.

Respondent states that Petitioner's summary judgment motion includes Godaddy.com receipts and WayBack Machine screenshots, documents not produced in discovery. Respondent states that it sought these matters in Interrogatory Nos. 5, 11, 17 and 28-34, and Document Request Nos. 4-5, 9-15, 20-21, 34, 37-38 and 44.¹²

- 5) The relevant class of consumers for Petitioner's services, including Petitioner's claim that there are no limitations to the type of customer; that the parties' customers are those wanting to listen to religious and spiritual music; and that it promotes to consumers of religious music and music videos.

Respondent states that it believes Petitioner's consumers are limited to a single location in Maryland, and that it sought these matters in Interrogatory Nos. 19-21 and 38, and Document Request No. 43.¹³

¹⁰ 12 TTABVUE 9.

¹¹ 12 TTABVUE 10.

¹² 12 TTABVUE 11-12.

¹³ 12 TTABVUE 13.

In its supporting declaration, in addition to attesting to the events and emails set forth above, Respondent's counsel states: "The Godaddy.com receipt attached to Petitioner's Motion were [sic] not provided to Registrant in discovery," and "To date, Petitioner has not produced any information or documents that show how Petitioner's Mark is displayed to the relevant consuming public, including but not limited to advertising or other promotional materials."¹⁴ The declaration incorporates by exhibit a copy of Respondent's interrogatories and document requests.¹⁵

Petitioner's Arguments

Petitioner contests the motion on the bases that Respondent fails to specify what discovery questions it seeks to have answered, why such information is essential to its response, or how discovery would preclude summary judgment. Petitioner also argues that Respondent's supporting declaration provides "no explanation as to why there is need for more discovery to show Petitioner lacks priority."¹⁶

Analysis

Respondent's Motion for Rule 56(d) Discovery

Petitioner's summary judgment motion places in issue any matters that are probative of Petitioner's asserted priority, and likelihood of confusion. In its Rule 56(d) motion, Respondent identifies specific matters in the summary judgment motion that Petitioner identifies therein as "undisputed facts," and sets forth the topics on which it requires information and documents in order to address these

¹⁴ 12 TTABVUE 15-17.

¹⁵ 12 TTABVUE 16, 30-50.

¹⁶ 13 TTABVUE 3-4.

arguments and show that there are genuine issues of material fact as to priority and key *du Pont* factors. In Board proceedings, a party invoking Rule 56(d) to obtain the discovery it believes it needs in order to prepare a response to a summary judgment motion is not required to have previously sought discovery. Nonetheless, here inasmuch as Respondent had in fact served discovery requests, it appropriately delineated the interrogatories and document requests through which it timely sought information and documents relevant to these topics. On this record, Respondent sufficiently explains in its motion the reasons why it is unable to prepare a response without discovery and confirms that what it needs is largely within Petitioner's possession, custody or control.

Respondent's Supporting Declaration

In applying Rule 56(d), the Board scrutinizes whether the movant's motion is supported by an affidavit or declaration that "states more than a mere speculative hope of finding evidence that might tend to support a claim." *Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 23 USPQ2d at 1475.

Here, Respondent's supporting declaration of counsel is sparse in detail regarding what facts it expects to find through discovery. However, it is sufficiently clear that the asserted need for discovery arose exclusively from Petitioner's conduct, and that denying Respondent discovery would result in an inequitable outcome and clear prejudice to Respondent. Moreover, although Respondent was not obligated to seek discovery before invoking Rule 56(d), potential inequity also may be found in the fact that Respondent did serve discovery requests, and, as soon as responses were past

due, it initiated correspondence with Petitioner aimed at securing responses. Then finally, in reply to Respondent's inquiry as to when the discovery responses would be forthcoming, Petitioner agreed to respond, but six days later, instead filed its motion for summary judgment.

In short, Respondent's need for Petitioner's discovery responses is evident under the circumstances: it seeks key information regarding priority and the various *du Pont* factors, the responsive information and documents are in Petitioner's possession and control, and after Petitioner stated by email that its responses would be sent, it instead moved for summary judgment.¹⁷ "Rule 56(f) provides nonmovants with protection from being 'railroaded' by premature summary judgment motions." *Opryland USA Inc.*, 23 USPQ2d at 1475 (quoting *Celotex v. Catrett*, 477 U.S. 317, 326 (1986)). Under these circumstances, the Board, with equitable principles at the fore, reads the motion and its supporting declaration **together** to ascertain whether the Rule 56(d) movant has met the rigors of that rule. In view of the undeniable impact of precluding Respondent from taking the discovery it needs, an impact due to Petitioner's decision to move for summary judgment in lieu of serving already overdue information and documents, the Board is hesitant to deny the protective relief that Rule 56(d) is intended to afford on the sole basis that Respondent's declaration is lacking in specifics.

¹⁷ Petitioner relies only on prior use of its mark. On summary judgment, and at trial in the event that summary judgment is denied, Petitioner carries the burden of proving it has priority. *See Am. Standard Inc. v. AQM Corp.*, 208 USPQ840, 841 (TTAB 1980).

Indeed, courts have noted a willingness to apply the Rule 56(d) affidavit or declaration requirement with a liberal approach where the party faced with defeating a summary judgment motion was not lax in pursuing discovery or where an inequitable outcome might otherwise result. *See, e.g., Nader v. Blair*, 549 F.3d 953, 961 (4th Cir. 2008) (strict compliance with Rule 56(d) affidavit may not be necessary where nonmovant, through no fault of its own had little or no opportunity to conduct discovery); *Harrods Ltd. v. Sixty Internet Domain Names*, 302 F.3d 214, 244 (4th Cir. 2002) (same). *See also* 10B Fed. Prac. & Proc. Civ. § 2740 (4th ed.) (“in certain circumstances courts have indicated that continuances would be proper even though Rule 56(d) had not been formally complied with when the court concluded that the party opposing summary judgment had been diligent and had acted in good faith.”).

Role of the Duty to Cooperate in Discovery

The Board finds it troubling that Respondent’s motion was born from Petitioner’s failure to cooperate in the discovery process. A fair characterization of the actions that led to this motion is that Petitioner chose to mislead Respondent with promised future service of its discovery responses while in fact it was preparing to file a summary judgment motion. Petitioner’s behavior is emblematic of how a party’s failure to meet its discovery obligations can lead to avoidable motions practice that stalls a proceeding.

The Board has made its expectations in this realm clear: “Each party and its attorney or other authorized representative has a duty . . . to make a good faith effort to satisfy the discovery needs of its adversary.” TBMP § 408.01. *See also Panda Travel*

Inc. v Resort Option Enter., Inc., 94 USPQ2d 1789, 1791 (TTAB 2009) (“The Board expects parties to cooperate during discovery. Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary.”); *Cadbury UK Ltd. v. Meenaxi Enter., Inc.*, 115 USPQ2d 1404, 1408 (TTAB 2015) (Board granted Respondent’s motion to compel noting that “Petitioner’s conduct has not demonstrated the good faith and cooperation that is expected of litigants during discovery. Such conduct has delayed this proceeding, unnecessarily increased the litigation costs of the parties, wasted valuable Board resources, and interfered with Respondent’s ability and, indeed, its right, to take discovery.”); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000) (granting judgment as a sanction under Trademark Rule 2.120(g)(1) where “applicant and its counsel have engaged in a pattern of dilatory tactics, have purposely avoided applicant’s discovery responsibilities in this case, and have willfully failed to comply with the Board’s ...order.”); *Johnston Pump/Gen. Valve Inc. v. Chromalloy Am. Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) (Board warned counsel for opposer that its conduct of discovery in the case was “uncooperative” and “improper” and that the Board “will not tolerate any further ‘game playing’ or evasiveness in discovery.” Opposer “ordered to cooperate in the effective and efficient completion of discovery in this case.”).

The Board rigorously applies the requirements of Rule 56(d), and denies such motions when they are unsupported, such as filed without an accompanying affidavit or declaration, or filed for the purpose of delay, or when they otherwise lack merit.

See, e.g., Keebler Co. v. Murray Bakery Prod., 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (motion for discovery denied; movant’s affidavit stated no reasons why it could not present facts essential to justify its opposition to summary judgment motion). *See also Harrods Ltd. v. Sixty Internet Domain Names, supra*, at 246 n.19 (“we hasten to add that parties who ignore Rule 56(f)’s affidavit requirement do so at their peril”). However, the Board will not penalize a Rule 56(d) movant whose motion is less than ideally supported when the motion arises from the actions of an uncooperative or recalcitrant adversary who gridlocks discovery. The Board will not hesitate to apply and balance equitable principles to address and rectify such situations, where appropriate.

Here, Respondent’s motion and declaration, read together, demonstrate a need for discovery that lies squarely within the ambit of Rule 56(d)’s purpose - to protect a party from being ambushed by a summary judgment motion filed before the party had a fair opportunity to obtain discovery that could bear on the disposition of the summary judgment motion. Respondent summed it up well: “Petitioner does not get to decide not to participate in discovery and then insist that no factual dispute exists.”¹⁸

Decision

Through reading its motion and supporting declaration together, and applying principles of equity as set forth herein, Respondent sufficiently specifies the topics to which the discovery pertains, and explains why the needed discovery is reasonably

¹⁸ 14 TTABVUE 3.

directed to obtaining facts essential to preparing its opposition to Petitioner's summary judgment motion. Accordingly, Respondent's motion for discovery pursuant to Fed. R. Civ. P. 56(d) is **granted**.

Schedule

Petitioner is allowed until **twenty days from the date of this order** to serve responses to the discovery requests that Respondent identified and the Board has determined to be relevant to priority and likelihood of confusion, namely: Interrogatory Nos. 4-5, 9, 11-39; and Document Request Nos. 4-16, 18-31, 33-34, 37-45. Petitioner must serve verified responses without objection on the merits of the discovery requests, must copy and serve all responsive documents rather than merely allowing inspection thereof, and must label all documents by Bates stamping. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000). In the event Petitioner fails to serve full and complete responses as directed herein, on its summary judgment motion or at trial Petitioner may be barred from relying upon or introducing documents, things or facts that were withheld. *See Fed. R. Civ. P. 37(c)(1)*.

Respondent's brief in opposition to the motion for summary judgment shall be due **sixty days from the date of this order**.

Proceedings otherwise remain suspended pursuant to Trademark Rule 2.127(d) pending disposition of Petitioner's motion for summary judgment.